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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,049	01/24/2002	Edward P. Hayes III	P-1672-1	5491

20978 7590 03/05/2004

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EXAMINER

COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

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DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,049

Applicant(s)

HAYES, EDWARD P.

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 16-18 and 20-22 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-13 is/are rejected.
- 7) ☒ Claim(s) 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 8-10, and 12-13, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,058,257 to Freestone et al in view of U.S. Patent 1,120,947 to Langager.

Freestone et al disclose a tool for inserting and removing a pin for a bucket tooth. As best shown in Figure 10, the tool comprises: a body member (214) defining a contact edge (232); a drive shaft (240) on the body member having a longitudinal axis (see marked-up attachment), a proximal end (224) attached to the body member, and a distal end which terminates in a shaft tip (240); an anvil (226) on the body member having a striking surface (228) at one end, an opposite terminal end, and a longitudinal striking axis (see marked-up attachment), when extended past the terminal end, intersects the longitudinal axis of the drive shaft at an acute angle, the striking surface facing away from the shaft tip; and a handle space (260).

However, Freestone et al do not disclose the handle extends transversely from a plane being defined by the longitudinal axis of the drive shaft and the striking axis of the anvil.

Langager disclose a striking tool having a handle. The handle extends transverse from a plane defined by the longitudinal axis of the main shaft of the tool and the striking axis and the anvil of the tool.

Regarding claims 1 and 8, it would have been obvious to one of ordinary skill in the art, at the time of invention, to have provided a transversely extending handle to the tool of Freestone et al, in light of the teachings of Langager, in order to protect the hand while supporting the tool. Col. 1, lines 17-20.

Regarding claim 2, the anvil plate (226) of Freestone et al defines a striking surface in as much as Applicant's invention contemplates.

Regarding claim 3, as shown in Figure 10, esp. of Freestone et al the body member (214) defines a contact surface (rear section) that extends in a generally parallel relation to the longitudinal axis of the drive shaft.

Regarding claim 4, this claim requires a striking plate fixedly mounted along the rear edge of the body member and the anvil member is mounted on the striking plate perpendicular thereto. The language of this claim suggests the striking plate is a separable structural member from the anvil. Otherwise, the claim requires no other structural details. In Freestone et al, the anvil (actual striking member) is perpendicular with a striking surface of the body member, although the parts are integral. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a separable anvil member fixed to the striking surface of the body, since it has been held that constructing a formerly integral structure in various

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elements involves only routine skill in the art. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Regarding claim 9, the handle of Langager is removably attached to the body member can be configured to extend from either side of the body member by a threaded engagement (at 11).

Regarding claim 10, although the handle of Langager may be removable, it is nonetheless fixed mounted to the tool by a threaded engagement (at 11) once attached.

Regarding claims 12-13, Freestone et al, disclose, "a line drawn or extending perpendicular to an impact or striking face intersects the longitudinal axis of the tool at an acute angle" (col 8, lines 66-68). It is inherent, based on the Figure 10 (see marked-up copy) that the angle is between 40-60 degrees. However, although Freestone et al does not disclose a particular angle it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a 40-60 degree angle, since it has been held that discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955). Furthermore, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

3. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freestone et al/Langager as applied to claim 1 above, and further in view of U.S. Patent 5,012,567 to Hill.

Freestone et al/Langager disclose the invention cited above. However, they do not provide the striking plate with a tapered configuration.

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Hill discloses an impact tool having an oversized anvil (40) and a member to transmit force, a striking to a striking plate (30). The force anvil and transmitting member (30) are provided with additional reinforcing plates (49) to buttress the impact of a hammer. Col. 2, lines 59-63. The anvil is centered with respect to the force transmitting member. The narrow end of the taper of Hill faces away from the anvil, just like Applicant contemplates.

Regarding claim 5, it would have been obvious to one of ordinary skill in the art, at the time of invention, to have provided the striking plate with a tapered reinforcing configuration for the tool of Freestone et al/Langager, in light of the teachings of Hill, in order to provide additional reinforcement for impact with a hammer.

Regarding claim 6, the legs having a slot of Applicant correspond, generally to the design of the reinforcements of Hill, which receive the body member. Applicant uses a single plate, where Hill uses two distinctive plates for the same structure. It has been held that forming in one piece an article, which has formerly been formed in two pieces, and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claim 7, it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973). In Hill the reinforcements (49) are joined to the anvil and force transmitting member by welds.

Allowable Subject Matter

4. Claims 11, 16-18, and 20-22 are allowed.
5. Claims 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 11, 17, 18, and, 20 the prior art of record does not teach or suggest a tool or method for installing a retaining pin, comprising a drive shaft in combination with an adaptor sleeve that is placed over the drive shaft to receive the retaining pin, in combination with the other claimed subject matter. The prior art, esp. Freestone et al, discloses a tool having tool orientations to accomplish the installing and removing the pin. With Applicant's use of an adaptor sleeve only one tool orientation is required for both.

Regarding claim 14-15, 16, and 21-22 the prior art of record does not teach or suggest a tool for installing or removing retaining pins, comprising a shoe having a shim plate positioned between the contact surface and drive shaft, in combination with the other claimed subject matter. See Figure 4C.

Response to Arguments

7. Applicant's arguments filed January 5, 2004, have been fully considered but they are not fully persuasive.

With regards to claims 1 and 8, Applicant argues that the amendment adding "sole" before "striking surface" defines over the art of record. In response to Applicant's argument that Freestone includes additional structure (i.e., an additional striking surface) not required by Applicant's invention, it must be noted that Freestone discloses the invention as cited above. The fact that it discloses additional structure not claimed is irrelevant. In use as removal tool, Freestone requires the same striking surface as Applicant. It is only for use as an installation tool, that Freestone requires an additional striking surface. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Applicant's further arguments are believed to be moot.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter B. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Compton
Patent Examiner
AU 3726



DAVID P. BRYANT
PRIMARY EXAMINER